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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,664	03/28/2001	John Didomenico	23439-032-402	2433

29315 7590 04/26/2002

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC  
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11911 FREEDOM DRIVE, SUITE 400  
RESTON, VA 20190

EXAMINER

WACHSMAN, HAL D

ART UNIT PAPER NUMBER

2857

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/818,664

Applicant(s)

DIDOMENICO ET AL.

Examiner

Hal D Wachsman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:



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EXAMINER
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ART UNIT	PAPER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Hal D Wachsman  
Primary Examiner  
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1. The drawings are objected to by the Draftsperson's for the reasons stated on the PTO-948 form. Appropriate correction is required.
2. The declaration is objected to because the declaration indicates that U.S. application serial no. 09/621,869<sup>abandoned</sup> is abandoned however the Office records indicate that the case is still pending. The declaration is also objected to because it contains a statement at the end that the signature of inventor Craig S. Rendahl is conditional which is inappropriate to have in a declaration. Appropriate correction is required.
3. The Request Form for filing a continuing application under 37 C.F.R. 1.53(b) had an amendment "Amend the specification by replacing the first sentence with..." which is an improper amendment under 37 C.F.R. 1.121 and was not entered. Consequently, there is no statement of continuing data on page 1 of the specification. Appropriate correction is required.
4. There is some confusion with respect to the claim for priority because U.S. application serial no. 09/457,391 went abandoned 2-10-00 before the filing date of 09/621,869 which has a filing date of 7-21-00, therefore these two applications were not co-pending. Thus, it is not clear what the basis is for the priority claim. Appropriate explanation/correction is required.
5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate

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paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

6. On the PTO 1449 form for the IDS filed 3-28-01 the International Search Report has not been considered because the report in itself is not prior art.

7. Claims 1-21 are objected to under 37 C.F.R. 1.75(a) for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 1, line 5, contains the pronoun "it" which adds vagueness with respect to what exactly passes through the exhaust plume. This same type of problem also occurs in claim 7, line 5, claim 14, line 5, claim 20, line 6. In claim 1, line 6, it appears that the word "to" is missing before the word "generate". This same type of problem also occurs in claim 7, line 6. In claim 1, line 7, it appears that the word "the" is missing before the word "radiation". Claim 1, line 9, cites "said detection bands" however the antecedent basis is "at least two different detection bands". This same type of problem also occurs in claim 1, lines 11, 19, claim 7, lines 9, 11, 17, 19. Claim 1, lines 10-11, cite "a vehicle exhaust plume" however is this the same motor vehicle exhaust plume previously cited in the claim ? This same type of problem also occurs in claim 1, line 13, claim 7, line 13. The last two lines of claim 1 cite "at least in part on.....the second detection band" which is indefinite because it is not clear what else in addition to the determined intensity difference in the second detection band is being used in the basis for disregarding the radiation. This same type of problem also occurs in the last 2 lines of claim 7. The last line of claim 1 cites "the determined intensity difference in the second detection band" which lacks clear antecedent basis. This same type of problem

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also occurs in the last 2 lines of claim 8. The last line of claim 2 cites "the exhaust opacity" which appears should be "the vehicle exhaust plume opacity". This same type of problem also occurs in claim 3, lines 3 and 4, claim 10, lines 3, 4. In claim 6, line 1, it appears that the word "an" is missing before "apparatus". This same type of problem also occurs in claim 13, line 1. The last 2 lines of claim 7 cite "the determined intensity difference in the first detection band" which lacks clear antecedent basis. Claim 8, line 1, cites "the exhaust opacity measurement" which lacks clear antecedent basis. Claim 9, lines 6-7, cite "the intensity difference in the third detection band" which lacks antecedent basis. Claim 14, step c, cites "generating at least a first signal..." which is confusing because at least a first signal implies that there may be a second signal, third signal, etc. however further on in step c there is a reference to a second signal which means that there can be two second signals therefore. This same type of problem also occurs in claim 20, step c. Claim 14, step d, cites "the first and second generated signals" however the antecedent basis for the first signal was "at least a first signal". This same type of problem also occurs in claim 20, step d. Claim 14, line 18, cites "the exhaust opacity" which should be "the exhaust plume opacity". This same type of problem also occurs in claim 14, line 20, claim 15, line 2. Claim 16, lines 5-6, cite "gaseous component of the exhaust plume" which appears should be "at least one gaseous component of the vehicle exhaust plume". The preamble of claim 18 states "The method of claim 17 for use in determining the exhaust opacity of a diesel powered vehicle" which is confusing because it is different than the preamble of independent claim 14. Claim 18, line 7, cites "the third generated signals" which should be "the third

generated signal". In claim 18, line 9, it appears that the word "and" is missing after the semicolon. Claim 18, line 10, cites "the exhaust opacity" which it appears should be "the exhaust plume opacity". Claim 20, line 5, cites "a motor vehicle" however did the applicant actually intend here "a diesel powered vehicle". Claim 20, step e, cites "said intensity difference in said second detection band" which lacks clear antecedent basis. Claim 20, step f, cites "the intensity difference in the first detection band" which lacks clear antecedent basis. The last 2 lines of claim 20 cite "the exhaust opacity" which should be "the exhaust plume opacity". The examiner asks the applicant to better claim the limitations cited above. While the examiner understands the intentions of the applicant he feels confusion could be drawn from the limitations cited above. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-21 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The Affidavit In Support Of An Information Disclosure Statement from inventor Craig S. Rendahl, shows commercializing (i.e. "on sale") of the invention (see paragraph 7 of the affidavit), as well as public use and sale (see paragraphs 10 and 11

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of the affidavit) of the invention more than one year prior to the date of application for patent in the United States.

10. The following references are cited as being art of general interest: Peterson et al. which disclose an unmanned integrated optical remote emissions sensor for motor vehicles, Johnson et al. which disclose speed and acceleration monitoring using visible laser beams and Didomenico et al. which disclose selecting a filter for a remote sensing device.

11. No claims are allowed.

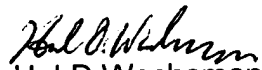
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal D Wachsman whose telephone number is 703-305-9788. The examiner can normally be reached on Monday to Friday 7:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 703-308-1677. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Hal D Wachsman  
Primary Examiner  
Art Unit 2857

HW  
April 23, 2002